REMARKS

Claims 1 to 52 are pending in the application. Claims 1 to 5, 7 to 10, and 49 to 52 are rejected under 35 U.S.C. § 112, first paragraph.. Claims 6 and 11 to 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 17 is objected to under 37 C.F.R. § 1.75. Applicants are herein amending the specification and claims 1, 13, 18, and 19.

Amendments

Applicants are herein amending the specification to properly recite that this application claims the benefit of U.S. Application Serial No. 60/410,082, filed September 12, 2002. Applicants are herein amending claim 1 to recite that "Ar" may be dihydrobenzodioxinyl. Support for the amendment may be found in dependent claim 17, where "Ar" is dihydrobenzodioxinyl. Applicants are herein amending claim 13, 18, and 19 to correct typographical errors. Applicants submit that no new matter is introduced by the amendments to the specification and claims.

Objection to Claims

Claim 17 is objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form. Applicants are herein amending claim 1 to specify that Ar may be a dihydrobenzodioxinyl moiety, thereby rendering moot the objection to claim 17. Accordingly, applicants request withdrawal of the objection to claim 17.

Claims 6 and 11 to 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants address the rejection of the base claims below.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 1 to 5, 7 to 10, and 49 to 52 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly nonenabled. Applicants respectfully traverse the rejection because the specification enables a person skilled in the art to which it pertains, or with which it is most nearly connected, to make and to use the invention commensurate in scope with claims 1 to 52.

In order to establish a *prima facie* case of non-enablement, the following must be established by the Patent Office:

1. a rational basis as to
    a. why the disclosure does not teach; or
    b. why to doubt the objective truth of the statements in the disclosure that purport to teach;
2. the manner and process of making and using the invention
3. that correspond in scope to the claimed invention
4. to one of ordinary skill in the pertinent technology,
5. without undue experimentation, and
6. dealing with subject matter that would not already be known to the skilled person as of the filing date of the application.

Any rejection under 35 U.S.C. § 112, second paragraph, for lack of enablement, must include evidence supporting each of these elements. Applicant respectfully submits that the Office has failed to meet its burden of establishing a *prima facie* case of non-enablement.

It has been consistently held that the first paragraph of 35 U.S.C. § 112 requires nothing more than *objective* enablement. Furthermore, a specification that teaches how to make and use the invention in terms which correspond in scope to the claims *must* be taken as complying with the firs paragraph of 35 U.S.C. § 112, *unless* there is reason to doubt the objective truth of the statements relied upon therein for enabling support. *Stahelin v. Secher*, 24 U.S.P.Q.2d 1513, 1516 (B.P.A.I. 1992) (citing *In re Marzocchi*, 439 F.2d 220, 169 USPQ

367 (C.C.P.A. 1971). "[I]t is incumbent upon the Patent Office, whenever a rejection on this basis is made, to ... back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement." *In re Marzocchi*, 439 F.2d 220, 224, 169 U.S.P.Q. 367, 370 (C.C.P.A. 1971).

In the instant application, the Office has asserted that the specification does not provide adequate support of how to make and/or use the invention because the working examples are allegedly not representative of the scope of compounds of Formula I. As such, it is alleged that the remaining compounds do not have the asserted activity because the applicants have not tested them for SSRI/$5HT_{1A}$ antagonist activity. It is respectfully submitted that it is not the applicants' burden to prove by testing the compounds that they have the SSRI/$5HT_{1A}$ antagonist activity, it is the Office's burden to establish that there is a reasonable basis supported by the evidence to doubt that the compounds do not have the asserted activity. While the Office alleges that no other compounds of similar substitution pattern are known in the art, its analysis of the enablement requirement is incorrect. The correct analysis should focus on the fact that the prior art does not disclose any compounds with a similar substitution pattern that do not have SSRI/$5HT_{1A}$ antagonist activity.

A lack of working examples with a large number of compounds does not automatically make a patent non-enabling. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 U.S.P.Q. 409 (Fed. Cir. 1984). Additionally, 35 U.S.C. § 112 does not demand a "working example," and an application cannot be fatally defective merely because it lacks one. *In re Long*, 151 U.S.P.Q. 640 (C.C.P.A. 1966); *In re Honn et al.*, 150 U.S.P.Q. 652 (C.C.P.A. 1966); *In re Bartholome et al.*, 156 U.S.P.Q. 20 (C.C.P.A. 1967); and *Ex parte Kenega*, 189 U.S.P.Q. 62 (Pat. Off. Bd. App. 1974).

Furthermore, the specification provides detailed synthesis schemes for preparing the compounds of Formula I (page 9, line 16 to page 24, line 1) and specific instructions for the synthesis of 39 representative compounds (page 29, line 17 to page 71, line 15). In addition, the specification provides general guidelines for formulating the compounds in

pharmaceutical compositions and preparing a variety of dosage forms (page 27, line 1 to page 28, line 19) and dosage levels of the compounds for use in methods of treating conditions treated by inhibiting the selective reuptake of serotonin (page 28, line 19 to page 29, line 2). The specification also provides procedures for the assay to determine the affinity for the 5-HT transporter, the assay for the 5-HT_{1A} receptor, and the assay for the antagonist activity at 5-HT_{1A} receptor of the compounds useful in the methods of the invention (page 24, lines 2-25). Moreover, the specification provides data on page 25 to show that representative compounds of the invention are combined serotonin reuptake inhibitors (SSRI) and 5-HT_{1A} antagonists. As such, the compounds of Formula I are useful for the treatment of diseases commonly treated with the administration of SSRI antidepressants.

Applicants further submit that the skilled artisan would accept the disclosed model as reasonably correlating to the claimed effects and, as such, the Office must consider accept the objective truth of the information, unless there is evidence in the record to the contrary. *See In re Brana*, 51 F.3d 1560, 1566 (Fed. Cir. 1995) (reversing the decision that *in vitro* data did not support *in vivo* applications); Manual of Patent Examining Procedure § 2164.02.

Because the non-enablement rejection is not supported by sufficient evidence that the compounds of Formula I and methods of their use cannot be made and used in the manner described in the specification without undue experimentation, applicants respectfully submit that there is not a reasonable basis for rejecting the claims. Accordingly, applicants respectfully request reconsideration and withdrawal of the rejection of the claims 1 to 5, 7 to 10, and 49 to 52 under 35 U.S.C. § 112, first paragraph, for being non-enabling.

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Wendy A. Choi
Registration No. 36,697

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439